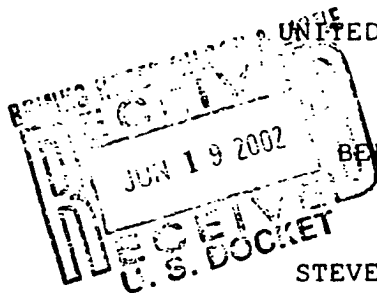




The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 54



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

STEVEN BLOEMBERGEN and RAMANI NARAYAN,

Junior Party,¹

v.

STEPHEN RIMSA and PAUL TATARKA,

Senior Party.²

Patent Interference No. 103,952

FINAL HEARING: MAY 16, 2002

Before CAROFF, ELLIS, and LORIN, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

FINAL DECISION

This interference involves a patent of the junior party,

¹Patent 5,462,983, granted October 31, 1995, based on Application 08/097,563, filed July 27, 1993. Assignment to Evercorn, Inc.

²Application 08/367,370 filed December 30, 1994. Accorded the benefit of U.S. Application No. 07/995,237, filed December 22, 1992, now abandoned, and Application No. 07/957,924 filed October 7, 1992, now abandoned. Assignment to National Starch and Chemical Investment Holding Corp.

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Bloembergen et al. (Bloembergen), and an application of the senior party, Rimsa et al. (Rimsa). According to the record before us, the Bloembergen patent is assigned to Evercorn, Inc., and the Rimsa application is assigned to National Starch and Chemical Investment Holding Corporation.

The subject matter in issue relates to a moldable composition including a starch ester having a degree of substitution (DS) of about 1.0 to about 2.5, and a biodegradable polyester. The composition is more specifically defined by the sole count of this interference as follows:¹

1. A moldable composition comprising a compatible thermoplastic blend of a biodegradable predominantly amorphous, hydrophobic, water-repellant, starch ester having a degree of substitution of about 1.0 to about 2.5DS and a biodegradable polyester selected from the group consisting of poly (ε-caprolactone) or poly (6-caprolactone), poly (lactic acid) or polylactide, poly (glycolic acid) or polyglycolide, poly (hydroxybutyric acid), poly (hydroxyisobutyric acid), poly (hydroxy valeric acid), poly (hydroxybutyrate-co-valerate), poly (hydroxy alkanoates), and aliphatic biodegradable polyesters.

The claims of the parties which correspond to this count are:

Bloembergen: Claims 1-13

Rimsa: Claims 86-99

¹Two apparent typographical errors in the count are identified in the footnote on page 2 of Bloembergen's brief.

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Issues

The following matters were raised in the parties' briefs and, therefore, define the only issues before us:⁴

1. Whether evidence adduced by Bloembergen is sufficient to corroborate conception and actual reduction to practice of the composition defined by the count prior to Rimsa's effective filing date of Oct. 7, 1992.⁵

2. If Bloembergen is found to have adduced sufficient evidence to corroborate an actual reduction to practice of the invention at issue prior to Rimsa's priority date, whether Bloembergen abandoned, suppressed or concealed that invention within the meaning of 35 U.S.C. § 102(g).

⁴Although Bloembergen previously identified "derivation" as an issue to be raised at final hearing (Paper No. 29), Bloembergen has indicated in its brief at page 11 that it will not pursue that issue at final hearing; accordingly the issue of derivation is not before us.

⁵Although Rimsa's brief (page 5) makes passing reference to a question of Bloembergen's "diligence," that particular issue does not arise here since it was not argued in Bloembergen's brief and no evidence has been proffered by Bloembergen on that point. Therefore, in order to establish prior inventorship, Bloembergen must prove to have been the first to have actually reduced the invention at issue to practice regardless of any earlier date of conception.

In this regard, we also note that Rimsa has indicated on page 6 of its brief that it does not contest that Bloembergen had a conception of the invention defined by the count prior to Rimsa's priority date of Oct. 7, 1992.

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The party Bloembergen has presented a record in the form of declaration testimony, and also submitted documentary exhibits.

Senior party Rimsa elected not to cross-examine any of Bloembergen's declarants, and has chosen not to present any witness testimony of its own. Both parties filed briefs and appeared, through counsel, at final hearing.⁶

No issue of interference-in-fact has been raised in this proceeding.

OPINION

At the outset, we note with regard to the issue of abandonment, suppression and concealment, that Rimsa apparently failed to satisfy the notice requirement of 37 CFR § 1.632. Moreover, Rimsa's counsel specifically stated at final hearing that Rimsa no longer intends to pursue the issue. Accordingly, we shall treat the issue of abandonment, suppression, and concealment as having been withdrawn from consideration.

We now turn to the issue of prior inventorship. After a

⁶The record, exhibits, brief and reply brief of Bloembergen hereinafter are respectively referred to by the abbreviations BR, BX, BB and BRB followed by a pertinent page or exhibit number. Similarly, Rimsa's brief will be referred to as RB.

We also note that Rimsa's counsel indicated at final hearing that he had no objection to our consideration of Bloembergen's substitute reply brief (Paper No. 48) in place of the original reply brief submitted by Bloembergen (Paper No. 43).

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thorough evaluation of all the evidence of record in this proceeding in light of the opposing positions taken by the parties in their respective briefs, we conclude that Bloembergen has failed to adduce sufficient evidence to corroborate that a composition within the scope of the count was actually reduced to practice prior to Rimsa's effective filing date of Oct. 7, 1992.

Bloembergen, as the junior party, has the burden of proving prior inventorship by a preponderance of the evidence. Peeler v. Miller, 535 F.2d 647, 651-52, 190 USPQ 117, 120-21 (CCPA 1976). Bloembergen alleges that the invention at issue was actually reduced to practice as early as Dec. 6, 1991 and, a second time, by Jan. 9, 1992. In attempting to prove these allegations, Bloembergen primarily relies upon the testimony of Dr. Mahendra K. Jain and entries in the notebooks of co-inventor Bloembergen (Notebook No. 200) and research aide Amy Gustafson (Notebook No. 244).

Even though the senior party did not cross-examine any of Bloembergen's declarants, and did not present any evidence of its own, Bloembergen must nevertheless provide adequate corroboration of an alleged actual reduction to practice to establish a prima facie case for prior inventorship. The need for corroboration by a non-inventor to establish a prima facie case for priority is a

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fundamental and well-established principle of interference practice. Rivise and Caesar, Interference Law and Practice, Vol. III, § 539 (Michie Co. 1947). Indeed, corroboration is required with regard to all the essential elements of a case for priority.

The purpose of the rule requiring corroboration is to reduce the potential for fraud and to establish, by proof that is unlikely to have been fabricated or falsified, that the inventor, or those working on behalf of the inventor, successfully reduced the involved invention to practice. Berry v. Webb, 412 F.2d 261, 266-67, 162 USPQ 170, 174 (CCPA 1969).

The evidence necessary for corroboration is determined by the rule of reason which involves an examination, analysis and evaluation of the record as a whole so that a reasoned determination as to the credibility of the inventor's story may be reached. Berges v. Gottstein, 618 F.2d 771, 776, 205 USPQ 691, 695 (CCPA 1980). Although adoption of the "rule of reason" has eased the requirement of corroboration with respect to the quantum of evidence necessary to establish the inventor's credibility, it has not altered the requirement that corroborative evidence must not depend solely on the inventor

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himself and must be independent of information received from the inventor. Reese v. Hurst, 661 F.2d 1222, 1225, 211 USPQ 936, 940 (CCPA 1981); Mikus v. Wachtel, 542 F.2d 1157, 1159, 191 USPQ 571, 573 (CCPA 1976).

As regards the alleged Jan. 9, 1992 reduction to practice, Dr. Jain testified that Bloembergen prepared a blend of a starch ester and a biodegradable polyester. Bloembergen is also said to have formed flexible film from the composition he had prepared (BR-7, para. 19; BX-1010). No inference adverse to Rimsa's position can be drawn from the fact that the senior party elected not to cross-examine Dr. Jain. Bosies v. Benedict, 27 F.3d 539, 543, 30 USPQ2d 1862, 1865 (Fed. Cir. 1994). On the other hand, there is at least a strong presumption that the testimony of Dr. Jain is accurate. McBride v. Acord, 201 USPQ 549, 551-52 (Bd. Pat. Int. 1977). However, as we see it, the fundamental issue here is not the accuracy of Dr. Jain's testimony but, rather, its adequacy as corroborative evidence. To wit, there is nothing in the Jain declaration which specifically indicates that Jain's knowledge of events was acquired independently of information he received directly from co-inventors Bloembergen and Narayan. Indeed, just the opposite appears to be the case.

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The only specifics attested to by Dr. Jain regarding his relationship to the alleged activities of co-inventor Bloembergen on Jan. 9, 1992 are to the effect that he read, understood and witnessed the entries made in Bloembergen's notebook (BR-2, para. 4; BR-7, para. 19). The fact that entries in the notebook indicate that Jain signed the notebook pages on dates later than Jan. 9, 1992, is consistent with an inference that Jain did not directly participate in or observe any of the alleged activities of co-inventor Bloembergen on Jan. 9, 1992 (BX-1010).

We are mindful that there are other more general statements in the Jain declaration to the effect that he had "personal knowledge" or was "personally aware" of Bloembergen's research efforts. However, these general statements do not establish that Jain's personal knowledge of the activities attested to was acquired independently of information he received from the inventors. Accordingly, it has not been established that Dr. Jain had first-hand knowledge of any of the work reported in Bloembergen's notebook other than what he was told by the inventors or read in Bloembergen's notebook.

For the foregoing reasons, we hold that Bloembergen has failed to establish that an actual reduction to practice occurred on or about Jan. 9, 1992 for lack of adequate corroboration.

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Turning to the purported actual reduction to practice on or about Dec. 6, 1991, Bloembergen again primarily relies upon the testimony of Dr. Jain as well as upon entries in the Gustafson notebook. Gustafson not being a named inventor, we can agree with Bloembergen that Gustafson's notebook entries constitute some circumstantial evidence of an independent nature to corroborate that a composition within the scope of the count was prepared on or about Dec. 6, 1991. Dr. Jain testified that Gustafson prepared the composition on Dec. 6, 1991 and determined that the blend was soluble in acetone (BR-6, para. 16-17; BX-1008, 1009).

However, the evidence as to the purported Dec. 6, 1991 reduction to practice is deficient essentially for two reasons. First, there is no evidence of record which demonstrates and corroborates that the composition prepared on Dec. 6, 1991 was "moldable," as required by the count, or was otherwise tested to establish that it had some practical utility. Reduction to practice of a composition is generally not considered complete until it has been successfully tested to establish its utility. Fujikawa v. Wattanasin, 93 F.3d 1559, 1563, 39 USPQ2d 1895, 1899

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(Fed. Cir. 1996); DeSolms v. Schoenwald, 15 USPQ2d 1507, 1510-11 (Bd. Pat. App & Int. 1990); Blicke v. Treves, 241 F.2d 718, 720, 112 USPQ 472, 475 (CCPA 1957).

Second, evidence is lacking with regard to whether Gustafson was working independently of the named inventors or on their behalf. Certainly, there is no evidence of record which indicates that Gustafson tested the composition at issue for any intended purpose or, if she had, that the composition was prepared and tested at the behest of the inventors and was recognized as being successful. Cf. Genentech Inc. v. Chiron Corp., 220 F.3d 1345, 1352-54, 55 USPQ2d 1636, 1641-43 (Fed. Cir. 2000).

For the foregoing reasons, we hold that Bloembergen has failed to establish that the work of Amy Gustafson on Dec. 6, 1991 constituted a complete actual reduction to practice of the invention defined by the count which inures to the benefit of Bloembergen.

Finally, we note that Bloembergen also relies to some extent on the declarations of Todd Ireland and Ramani Narayan. However, in our view those declarations do not remedy the inadequacies of the Jain declaration which we have noted, supra. Ireland merely

indicates that Gustafson prepared a modified starch ester (one component of the composition at issue) on Sept. 16, 1991, and that he witnessed her notebooks. Narayan's declaration relates to the question of derivation, which is not at issue here. Moreover, since Narayan is a named co-inventor, his statements do not have corroborative value.

For all of the foregoing reasons, judgment as to the subject matter of the sole count in issue is hereby awarded to Rimsa et al., the senior party.

Bloembergen et al. are not entitled to their patent claims 1-13 which correspond to the count.

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